

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCEL AUBERON,
JEAN-PHILIPPE LEARD
and JEAN-FRANCOIS FUCHS

Appeal No. 1999-0621
Application 08/378,376

ON BRIEF

Before COHEN, McQUADE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Marcel Auberon et al. originally took this appeal from the final rejection of claims 22 through 31. The appellants

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have since canceled claim 22, amended claims 23, 24, 26, 27,
28 and

30, and added claim 32. As a result, claim 21 (which was not
finally rejected) and claims 28, 29 and 32 stand allowed. The
appeal now involves claims 23 through 27, 30 and 31.

THE INVENTION

The invention relates to "monoblock connecting rods made
of a composite material" (specification, page 1). Claim 31 is
illustrative and reads as follows:

31. A monoblock connecting rod comprising:

a body of composite material having a longitudinal axis,
said body of composite material including fibers placed by
successive layers oriented with respect to a longitudinal axis
of the monoblock connecting rod along various angles between
and including at least one of approximately 0° and 90°;

a tubular running portion;

two fixing end portions; and

tubular transition portions between said running portion
and said two fixing end portions.

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THE PRIOR ART

The references relied upon by the examiner as evidence of obviousness are:

Ashton et al. (Ashton) 1976	3,970,495	Jul. 20,
Worgan et al. (Worgan) 1978	4,089,190	May 16,
Stephan et al. (Stephan) Sept. 15, 1987	4,693,140	
Orkin et al. (Orkin) 1987	4,704,918	Nov. 10,
Tice 27, 1989	4,841,801	Jun.

THE REJECTIONS

Claims 23 through 27, 30 and 31 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.¹

¹The examiner entered this rejection for the first time in the main answer (Paper No. 24).

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Claims 23 through 25 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephan in view of Ashton.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephan in view of Ashton and Tice.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephan in view of Ashton and Worgan.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephan in view of Ashton and Orkin.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 23, 25 and 27) and to the examiner's main and supplemental answers (Paper Nos. 24 and 26) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

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The 35 U.S.C. § 112, second paragraph, rejection, rests on the examiner's determination that claims 23 through 27, 30 and 31 are indefinite because

[i]n lines 4-5 of claim 31, "approximately 0 degrees [sic, 0E] and 90 degrees [sic, 90E]" is vague and indefinite since Applicant [sic] has not stated in the original specification nor in any arguments filed thereafter, what specifically is meant by "approximately". In claims 23 and 24, "strap-shaped" is indefinite since it is not clear what the shape of a strap is [main answer, page 7].

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The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this requirement is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. The purpose of the requirement is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

The appellants' specification (see page 5) indicates that

a "strap-shaped" connecting rod end portion comprises two parallel cheeks having rectangular sections and opposing holes.² When read in this light, the recitation in claims 23 and 24 of "strap-shaped" end portions is reasonably particular and precise, and thus does not pose an indefiniteness problem.

The same cannot be said for the "approximately 0E and 90E" limitation in claim 31. The term "approximately" is a word of degree. Definiteness problems often arise when words of degree are used in a claim. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984). When a word of degree is used, it must be determined whether the specification provides some standard for measuring that degree. Id. The appellants' reliance on the statement on specification page 7 that "[w]inding and laying down shall be effected along various angles, for example 0 degrees, \pm 25 degrees, \pm 45 degrees; 90 degrees" for

²By way of contrast, the specification (see page 10) indicates that a "flattened head" connecting rod end portion (see claim 24) comprises a single cheek having a hole.

the requisite standard (see page 4 in the first reply brief, Paper No. 25) is not well taken because the statement gives no guidance as to what "approximately" 0E and 90E might mean. The difficulty with the limitation is exemplified by the dispute in this appeal as to whether the limitation is met by Ashton's disclosure of a 5E angle, i.e., whether 5E is "approximately" 0E. The record does not provide any reasonable basis for answering this question one way or the other. The case law cited by the appellants to support their position (see page 4 in the first reply brief, Paper No. 25; and page 3 in the second reply brief, Paper No. 27)³ is not convincing due to the fact specific nature of the issue. Moreover, the pertinent portions of the cited cases deal with the issues of patentability over the prior art or infringement rather than claim indefiniteness.

Thus, due to its inclusion of the word "approximately," claim 31, and claims 23 through 27 and 30 which depend

³ Amhil Enter. Ltd. v. Wawa, Inc., 81 F.3d 1554, 38 USPQ2d 1471 (Fed. Cir. 1996); Dippin' Dots v. Mosey, 44 USPQ2d 1812 (N.D. Tex. 1997); Ex parte Shea, 171 USPQ 383 (Bd. App. 1970).

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therefrom, fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Therefore, we shall sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.

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We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejections of claims 23 through 27, 30 and 31. Given the indefinite scope of these claims, the prior art rejections must fall since they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

Finally, upon return of the application to the technology center, the examiner should reconsider:

i) the allowability of product-by-process claim 21 in view of the prior art of record, keeping in mind the principle that it is the patentability of the product claimed and not of the recited process steps which is dispositive (see In re Thorpe,

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777 F.2d 695, 697-98, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972));

ii) the allowability of claim 32 in view of Ashton's disclosure of filaments wound at angles of "from 45E to about 90E" (column 4, line 25), which disclosure appears to be at odds with the reasons for allowance set forth on page 3 in the supplemental answer; and

iii) the allowability of claims 28 and 29 in view of the prior art of record, particularly Stephan's disclosure (see Figure 4) of a monoblock connecting rod having transition portion walls of progressive thickness and end portion elements of constant thickness and Ashton's disclosure (see column 4, lines 17 through 60) of monoblock connecting rod filament/fiber angles.

In summary, since at least one of the examiner's rejections of each of claims 23 through 27, 30 and 31 has been sustained, the decision of the examiner to reject these claims is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

AFFIRMED

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
	JOHN P. McQUADE))
APPEALS			
	Administrative Patent Judge)	AND
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INTERFERENCES			
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	JOHN F. GONZALES)	
	Administrative Patent Judge)	

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